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EXAMINER

DEXTER, CLARK F

ART UNIT PAPER NUMBER

3724

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/601,828

Applicant(s)

DENG ET AL.

Examiner

Clark F. Dexter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 2-15 and 20-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 16-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 June 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group III, Species B (claims 1 and 16-19) in the reply filed on November 2, 2004 is acknowledged. Claims 2-15 and 20-31 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention/species.

Oath/Declaration

2. It is noted that the specification to which the oath or declaration is directed has not been clearly identified because the appropriate box has not been checked. However, because the date and application serial number have been provided, it is assumed that applicant's intention was to check the second box (i.e., "was filed on"). If this assumption is not accurate, applicant must respond with a proper oath/declaration.

Drawings

3. The drawings are objected to because of the following informalities:

In Figure 3C, numeral 112 is inaccurate, and it seems that it should be changed to --110--;

In Figure 3D, the upper left occurrence of numeral 112 is inaccurate, and it seems that it should be changed to --110--.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

4. The disclosure is objected to because of the following informalities:

On page 14, line 16, the second occurrence of "outer" appears to be inaccurate, and it seems that it should read --inner-- or the like.

On page 18, lines 1, 3, 8, 10 and 12, each occurrence of "112" is inaccurate, and it seems that it should read --100-- or the like.

On page 21, last line, "204" appears to be inaccurate, and it seems that it should be changed to --304-- or the like.

On page 22, line 1, "third" and "fourth" appears to be inaccurate, and it seems that they should be changed to --second-- and --third--, respectively, or the like.

On page 23, line 12, "my" is improper and it seems that it should read --may-- or the like.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 18, lines 2-3, the recitation "has a thickness for allowing use of said die cutting apparatus with an existing die cutting apparatus" is vague and indefinite as to what "thickness" is being set forth.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent

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granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1, 16 and 18, as understood, are rejected under 35 U.S.C. 102(e) as being anticipated by Johnson, pn 6,658,978.

Johnson discloses a die cutting apparatus (e.g., in Figures 1-4) with every structural limitation of the claimed invention as best understood from the claims including a metal base portion (e.g., 7) defining a channel (e.g., 21), a blade (e.g., 8) within the channel, wherein the blade is bonded to the base portion, and a covering (e.g., 1).

Claim Rejections - 35 USC § 102/103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

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invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 1, 16, 18 and 19, as understood, are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sarka et al., pn 3,863,550.

Sarka discloses a die cutting apparatus with every structural limitation of the claimed invention as best understood from the claims including a metal base portion (e.g., 2) defining a channel (e.g., 12), a blade (e.g., 15) within the channel, wherein the blade is bonded to the base portion, and a covering (e.g., 21, 22).

In the alternative, if it is argued that there is no explicit disclosure of the blade being bonded to the base portion, the Examiner takes Official notice that such bonding is old and well known in the art in various forms to secure the blade in place. Therefore, it would have been obvious to one having ordinary skill in the art to bond the blade to the base portion for the well known benefits including that described above.

Claim Rejections - 35 USC § 103

10. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson, pn 6,658,978.

Johnson lacks the covering comprised of plastic. However, the Examiner takes Official notice that making die cutting apparatus components from plastic is old and well known in the art and provides various well known benefits including providing a

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lightweight material that is resistant to environment compared to other "suitable materials" such as wood-based materials. Therefore, it would have been obvious to one having ordinary skill in the art to make the covering from a material that comprises plastic for the well known benefits including those described above.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark F. Dexter whose telephone number is (703)308-1404. The examiner can be reached Monday through Friday during normal business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on (703)308-1082. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Clark F. Dexter', is positioned above the printed name.

Clark F. Dexter
Primary Examiner
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cfid
December 9, 2004